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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,590	12/31/2003	Bradley Nelson	AUS920030119US1	8597
42640 7590 05/24/2007 DILLON & YUDELL LLP 8911 NORTH CAPITAL OF TEXAS HWY SUITE 2110 AUSTIN, TX 78759			EXAMINER SILVER, DAVID	
			ART UNIT 2128	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/750,590

Applicant(s)

NELSON ET AL.

Examiner

David Silver

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 6, 12, 16, 21, 27, 31, 36 and 42.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

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The Instant Application, as claimed, is not currently in condition for allowance.

Response: 35 U.S.C. § 101

1. The background sections reflect the position of the Previous Office Action and apply to those claims that remain pending. Meaning, rejections / objections / claim interpretations relating to canceled claims are moot.

2. **Background:**

Claims 6-11 and 31-44 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. (Previous Office Action)

3. **Applicant argues:**

- 3.1 "Applicant respectfully points out that independent Claims 31, 36 and 42 all explicitly recite "a tangible computer usable medium" in the body of the claim following the transitional phrase "comprising" (see, e.g., MPEP 2111.03 for a discussion of transitional phrases). Applicant is therefore puzzled why the Examiner has not attributed patentable weight to the explicitly recited "tangible computer readable medium" and believes that no "appropriate medium" is recited in Claims 31-44. Because the Examiner's position is clearly in error, Applicant respectfully submits that the rejection of Claims 31-44 under 35 U.S.C. § 101 is not well founded and should be withdrawn." (Remarks: page 9)
- 3.2 "In paragraph 17.2, the Examiner states that Claims 6-11 "do not produce a useful, tangible and concrete final result." Applicant again respectfully traverses the Examiner's position because Claim 6 recites "placing the simulation model in data storage," which provides a useful, tangible, and concrete result, namely, a simulation model for an electronic design residing in data storage. Applicant again is puzzled why the Examiner states that the claims "merely recite a software algorithm, per se, which, for example, does not display, store, or otherwise provide a useful tangible output" (emphasis supplied) when Claim 6 explicitly recites a step of "placing the simulation model in data storage". Placing the simulation model in data storage as claimed is clearly a "storing" step,

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which the Examiner admits provides a useful tangible output, namely, data storage having its contents arranged to provide a simulation model of an electronic design. Because the Examiner admits that storing an output as claimed provides a useful, tangible result, Applicant respectfully submits that the rejection of Claims 6-11 under 35 U.S.C. § 101 is not well founded and should be withdrawn." (Remarks: page 10)

4. **Examiner Response:**

4.1 Regarding subsection 1 above, the preamble contains two transition phrases. To help illustrate this, the following direct quotation is provided with emphasis for Applicant's convenience:

"31. An apparatus **comprising** a tangible computer useable medium containing program code, said program code **including:**"

"36. An apparatus for preparing a simulation model of an electronic design, said apparatus **comprising** a tangible computer usable medium containing program code, said program code **including:**"

"42. An apparatus **comprising** a computer useable medium containing program code, said program code **including:**"

The claims contain multiple transition phrases, because the last transition phrase if followed by indented limitations, it is asserted that the limitations **following** the second transition phrase are limitations of the claims. It is further noted, that if the first limitations is to be considered part of the claim body then 1) the limitations drawn to the medium should be placed in the claim body (indented on a new line as limitations); 2) a 35 U.S.C. § 112 first and second paragraph rejections may not be unreasonable because a program code cannot include "means for" invocation. Specifically, code cannot include structure.

The 35 U.S.C. § 101 rejections of claims 31, 36, 42 are **maintained**.

4.2 Regarding subsection 2 *supra*, Applicant' arguments have been fully considered and are persuasive.

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The 35 U.S.C. § 101 rejection of claim 6 is **withdrawn**.

5. **Background:**

Claims 1-14, 16-29 and 31-44 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (Previous Office Action)

The "term 'any storage elements' fails to specifically set the metes and bounds of the claim; thus, rendering the claim indefinite. This statement creates ambiguity that requires clarification.

Specifically, does the phrase mean the inclusion of optional storage devices if any are needed, or does it refer to any type of storage element?

6. **Applicant argues:**

"Applicant respectfully traverses the Examiner's position because the phrase "any storage elements" is not indefinite in that it clearly means the storage elements (e.g., latches, flip-flops, etc.), if any, that are present within the design entities of the electronic design. Furthermore, even if the Examiner were to adopt the supposed alternative interpretation of "any type of storage elements", the meaning would be one and the same. That is, the statements in the HDL files would still specify any types of storage elements (e.g., latches, flip-flops, etc.) that define function operation of the electronic design.

Moreover, Applicant respectfully reminds the Examiner that, according to MPEP 2173.02, the Examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." Because the present claims satisfy the requirement of a reasonable degree of precision, Applicant respectfully submits that the rejection under 35 U.S.C. § 112, second paragraph, is not well founded and should be withdrawn." (Remarks: page 10 bottom to 11 top; underlined emphasis added)

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7. Examiner Response:

The term "any" fails to set the metes and bounds. Even when attempted to traverse the deficiency the Applicant was unable to set the metes of the definition and relied on terms such as "etc", which, again, fail to set the metes and bounds. MPEP 2173.02 requires at least a degree of particularity and distinctness, which in this case was not adequately asserted.

It appears that Applicant has misunderstood the *prima-facia* rejections. Further explanation is provided as follows. Paragraph two of 35 U.S.C. § 112 contains two separate requirements: (A) the claims must set forth the subject matter that applicant regards as their invention; and (B) the claims must particularly point out and distinctly define the **metes and bounds** of the subject matter that will be protected by the patent grant. The instant claims were not rejected for failing to particularly point out and distinctly claim the subject matter that is regarded as Applicant's own.

Applicant's attention is drawn to MPEP 2173.02, which also recites, in part: "If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int 'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)." In this case, the vague term "any" and the boundless term "etc" fail to set the metes and bounds; thus, rendering the claims indefinite.

The 35 U.S.C. § 112 rejections are **maintained**.

8. Examiner Response:

Applicant's arguments on page 11 first full paragraph (regarding paragraph 20 of Previous Office Action) have been considered but are unpersuasive. See Previous Office Action. The 35 U.S.C. § 112 rejections are **maintained**.

Response: 35 U.S.C. § 103

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9. Background:

Claims 1-14, 16-29 and 31-44 are rejected under 35 U.S.C. 103(a) as unpatentable over the combination of U.S. Patent No. 5,604,895 to Raimi and U.S. Patent No. 4,821,178 to Levin. (Previous Office Action)

10. Applicant argues:

"Applicant respectfully submits that exemplary Claim 1 is not rendered unpatentable by the combination of cited references because that combination does not disclose, teach or suggest each claimed feature. For example, the combination of Raimi and Levin does not disclose, teach or suggest the following step of exemplary Claim 1 as amended:

permitting a user to specify ... an instrumentation entity that monitors at least one design entity ... but does not contribute to functional operation of the electronic design, wherein specifying the instrumentation entity includes specifying a trace array within the instrumentation entity ..., wherein specifying a trace array includes specifying an association between an enumerated value and a value of the at least one signal comprising said monitored signal set. (emphasis supplied)

[...] Applicant has carefully reviewed the code example and the associated description provided by Raimi at col. 11, line 13 through col. 12, line 8 and notes that no such association between an enumerated value and a signal value is disclosed therein. Because the combination of Raimi and Levin does not disclose, teach or suggest each claimed feature, Applicant respectfully submits that the rejection of exemplary Claim 1 as unpatentable under 35 U.S.C. § 103 is overcome." (Remarks: page 12)

11. Examiner Response:

An enumerated value includes the following types: character values, boolean values, and severity_level (source: <http://www.vhdl.org/vhdlpli/IRS/IR04>). Attention is drawn to the code on **(col: 10 line: 48-51)**, which discloses the assignment (associated) of Boolean values to the

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enumerated values. Specifically, attention is drawn to the code "if (c) T.sub.-- chk[tbyte.sub.-- 6335] = `1`; else if (.about.c) T.sub.-- chk[tbyte.sub.-- 6335] = `0`;" Specifically, when the monitored signal 'c' is changed, the T_chk is changed (through assignment and therefore associated) accordingly to the respective value of the monitored signal 'c'.

Applicant's arguments have been fully considered but are **unpersuasive**.

The Instant Application, as claimed, is not currently in condition for allowance.


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